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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/421,055 04/12/95 JOHNSON

M 49286USA9C

EXAMINER

GALLAGHER, J

ART UNIT	PAPER NUMBER
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1301

DATE MAILED: 11/15/95

PATRICK J O'CONNELL
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13M1/1115

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ day(s) from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. (3) | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-5 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-5 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-5 are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 1301

15. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-4, ~~are~~ drawn to a bonding method, classified in Class 156, subclass 324.4.

II. Claim 5, ~~is~~ drawn to another bonding method, classified in Class 156, subclass 278.

16. The inventions are distinct, each from the other because of the following reasons: the inventions of Group I and II are held/seen to be mutually independent and distinct in that neither of these inventions requires the particles^{up} of the other._{cc}

17. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art, as shown by the above classification, and since the fields of search are coextensive, restriction for examination purposes as indicated is proper.

18. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. 37 CFR 1.143.

19. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least

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one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

20. In the interest expedition, the Examiner has been fit to both impose the restriction requirement and art on all claims presented viz. claims 1-5; further along this line, applicants should not confuse this action taken on all claims with what it held/seen to be the property of the requirement.

21. Applicants should note (WRT the Form PTO-1449's submitted) that ALL of the references cited in the two parent applications have been considered by the undersign^{ed} Examiner.

22. Applicants are requested to submit to the Office for consideration the closest^(P) prior art of which they may be aware (product spec sheets preferred) concerning the tradename materials referred to at page 29 lines 6-12 of the specification.

23. The disclosure is objected to because of the following informalities: (a) the patent number cited at page 29 line 14 is apparently in error; and (b) page 55 line 1 - change "Claims" to "We Claim" or equivalent, as per MPEP 608.01(m). Appropriate correction is required.

24. The specification is objected to as failing to provide

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proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(o). Correction of the following is required: apparently nowhere in the specification is the epoxy-polyester material characterized/referred to as a "priming layer" as it is (twice) in line 6 of claim 5; further along this line, see MPEP 706.03(n).

25. Claims 1-~~5~~ are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For the sake of avoiding confusion, it is felt that the second occurrence of the word "comprising" in line 4 of claims 1 and 5 should be changed to "including" or "to include".

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

27. Claim 5 is further rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Otonari et al.

Otonari et al disclose an adhesive composite composed of a

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polyester base layer film coated on eg. both sides with an adhesion improving/adhesive composition composed of at least one resinous material (eg. epoxy resins, polyesters etc.), which composite may be adhered to a substrate. (abstract, col 1 lines 12-18, col 3 lines 19-38, col 4 lines 21-23, col 7 lines 6-35, col 8 lines 51-55, col 9 lines 12-17). Any differences which might possibly/conceivably exist between the envisioned, claimed invention and the teachings of this reference are held/seen NOT to constitute patentable differences.

28. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

29. Claims 1-4 are further rejected under 35 U.S.C. § 103 as being unpatentable over any one of Worth or Kumanoya et al or

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Rinde et al, each in view of Pletcher.

Worth discloses an adhesive composite composed of a microcellular/microporous base layer having applied to one major surface thereof a crosslinkable adhesive, which composite is adhered to a substrate. (Figs 1 and 3, abstract, col 1 lines 24-27 and 31-35, col 2 lines 55-59, col 3 lines 20-25).

Kumanoya et al disclose an adhesive composite composed of a polyolefin (eg. polyethylene) resin base layer (to include ANY and ALL substrates made of polyolefin) having applied to one major surface thereof a settable (ie crosslinkable) adhesive, which composite is adhered to a substrate. (abstract, col 1 lines 17-21, col 3 lines 12-15, Example 1).

Rinde et al (cited and supplied by applicants) disclose an adhesive composite composed of an eg. polyethylene base layer (of ANY desired composition) having applied to one major surface thereof a curable/thermosetting adhesive, which composite is adhered to a substrate. (Fig 1, page 2 line 34 thru page 5 line 20, page 6 line 33 thru page 7 line 27, page 8 lines 13-19, page 9 lines 9-17).

Pletcher discloses that foams (to include polyolefin foams) are known to be utilized (eg. as an alternative to the use of polyolefin/polyethylene films) as backings/base layers in the

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construction of adhesive (eg. tape) composites of the type/similar to those disclosed in Worth, Kumanoya et al and Rinde et al (col 8 lines 57-68), such that it would have been obvious to one of ordinary skill in this art to employ such conventional, documented foam backings in the adhesive composites of Worth or Kumanoya et al or Rinde et al in place of the corresponding, analogous backing/base layer materials employed therein (especially in view of the direction/suggestion given one of ordinary skill in this art along this line by these respective patentees); more substitution of one known backing/base layer material for another such material involved.

30. Any inquiry concerning this communication should be directed to J. J. Gallagher at telephone number (703) 308-1971.

FT6
J. J. Gallagher/krb
November 6, 1995

11-9-95



JOHN J. GALLAGHER
PRIMARY EXAMINER
ART UNIT 131